

REMARKS

Applicant submits that the present amendment is fully responsive to the Office Action dated July 9, 2008 and, thus, the application is in condition for allowance.

By this reply, claims 1, 15, and 25 have been amended. Claims 6 and 7 have been canceled. Claims 1, 3-5, 8-10, 13, 15-23, and 25 are currently pending in the application. Of these, claims 1, 15, and 25 are independent. An expedited review and allowance of the application is respectfully requested.

In the outstanding Office Action, the specification was objected to due to failure to provide antecedent basis for “computer-readable medium” as recited in claim 25. However, a computer readable medium is well known in the art and was first presented in the originally filed claims of the initial disclosure. See, for example, claims 25 and 26 as originally filed. Therefore, such concept was part of the initial disclosure and has support in the application as originally filed. Thus, the claims should be allowable.

In the outstanding Office Action, claims 1, 3-6, 8-9, 15-18, 20-22, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Isaacs et al. (US 2004/0215728). It is asserted that Isaacs discloses substantially each element of the present invention as recited in the claims and therefore anticipates the claims. Applicant respectfully traverses.

With respect to independent claims 1, 15, and 25, Isaacs does not disclose or fairly suggest the present invention as recited in the pending claims. For example, Isaacs fails to teach or suggest, among other things, linking of an emoticon and a sound file wherein the linking occurs at the server according to user preferences stored on the server. Isaacs is directed to a system for transmitting earcons, not emoticons. The sender selects an icon (not an emoticon) and the system transmits a corresponding sound to the recipient. In other words, the invention of

Isaacs transmits only sound, not any corresponding text or image. Emoticons allow a user to visually represent an emotion. An emoticon is not even mentioned in Isaacs. Because an emoticon is not even mentioned, linking an emoticon and a sound file can not possibly be anticipated. Furthermore, linking the emoticon and sound file at a server according to user preferences which are stored on the server is also not anticipated. Because emoticons are not mentioned in Isaacs, it is not possible for preferences to be attached to emoticons at any level. Therefore, it is clearly not possible that these preferences are stored at the server level. For at least this reason, Applicant respectfully requests that this rejection be withdrawn.

Isaacs therefore does not teach all of the elements in the independent claims. Hence, the dependent claims, which depend therefrom, also are patentably distinct from any prior art of record. For this reason, Applicant respectfully requests withdrawal of the rejection.

Claims 1, 7, 15, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ostermann et al. (US 6963839) in view of Isaacs. It is asserted that Ostermann discloses substantially a method and apparatus according to the present invention as recited in the claims, but for determining if the recipient has a file prior to sending the file. It is further alleged that Isaacs does disclose this deficiency and the combination of these cited references would have therefore been obvious to one having ordinary skill in the art. Applicant respectfully traverses.

With respect to claims 1 and 15, neither Ostermann nor Isaacs, nor any other related art of record, alone or in combination, disclose or fairly suggest the present invention as recited in the pending claims. For example, Ostermann fails to teach or suggest linking of an emoticon and a sound file wherein the linking occurs at the server according to user preferences stored on the server. Ostermann is directed to a system and method for transmitting multi-media messages through a web server on the Internet. To the extent Ostermann discloses any part of the message

on the server, it is in the form of the server converting text into speech performed by an animated entity (Column 8, 17-28). Ostermann does not disclose any linking of sound files already on the server with an emoticon. Furthermore, Ostermann does not disclose that any such linking is done according to user preferences which have been stored on the server. For instance, this feature is particularly advantageous where the end user is on a cellular telephone service. The user can store preferences to a central server and thus the user's cellular phone would not be required to upload large amounts of data to the central server. This allows the user to simply enter an emoticon into their message and the server will link a sound file based upon the user's preferences. This feature is simply not present in Ostermann.

Isaacs fails to cure this deficiency in Ostermann. As stated above, Isaacs fails to even mention emoticons, let alone emoticon and sound file linking preferences stored on a central server. Therefore, the combination of Ostermann and Isaacs does not render the present invention obvious. For at least this reason, Applicant respectfully requests that this rejection be withdrawn.

Thus, neither Ostermann nor Isaacs, alone or in combination, teach all of the elements in the independent claims. Hence, the dependent claims, which depend therefrom, also are patentably distinct from any prior art of record. For this reason, Applicant respectfully requests withdrawal of the rejection. Furthermore, there is no motivation to combine any of these references outside of Applicant's own disclosure. Even if they were combinable, *arguendo*, the combination would not be able to obviate the present invention for at least the reasons set forth above. Thus, the rejection of the claims should be withdrawn.

Claims 1, 10, 15, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mages et al. (US 6463467) in view of Isaacs. It is asserted that Mages discloses

substantially a method and apparatus according to the present invention as recited in the claims, but for determining if the recipient has a file prior to sending the file. It is further alleged that Isaacs does disclose this deficiency and the combination of these cited references would have therefore been obvious to one having ordinary skill in the art. Applicant respectfully traverses.

With respect to claims 1 and 15, neither Mages nor Isaacs, nor any other related art of record, alone or in combination, disclose or fairly suggest the present invention as recited in the pending claims. For example, Mages fails to teach or suggest linking of an emoticon and a sound file wherein the linking occurs at the server according to user preferences stored on the server. Mages is directed to a method for transmitting protected video or graphic data over the Internet from a Web site. To the extent Mages discloses graphics or audio, it is not in the form of emoticons. Mages does not disclose any linking of sound files already on the server with an emoticon. Mages does not even disclose any linking occurring on the server. Any linking between a graphic and audio has already occurred before it reaches the server. Additionally, Mages does not disclose that any such linking is done according to user preferences which have been stored on the server. This feature is simply not present in Mages.

Furthermore, Isaacs fails to cure this deficiency in Mages. As stated above, Isaacs fails to even mention emoticons, let alone emoticon and sound file linking preferences stored on a central server. Therefore, the combination of Mages and Isaacs does not render the present invention obvious. For at least this reason, Applicant respectfully requests that this rejection be withdrawn.

Thus, neither Mages nor Isaacs, alone or in combination, teach all of the elements in the independent claims. Hence, the dependent claims, which depend therefrom, also are patentably distinct from any prior art of record. For this reason, Applicant respectfully requests withdrawal

of the rejection. Furthermore, there is no motivation to combine any of these references outside of Applicant's own disclosure. Even if they were combinable, *arguendo*, the combination would not be able to obviate the present invention for at least the reasons set forth above. Thus, the rejection of the claims should be withdrawn.

A THREE (3) month extension of time is hereby requested to enter this amendment. If any fees are associated with the entering and consideration of this amendment, please charge such fees to our Deposit Account 50-2882.

Applicant respectfully requests an interview with the Examiner to present more evidence of the unique attributes of the present invention in person. As all of the outstanding rejections have been traversed and all of the claims are believed to be in condition for allowance, Applicant respectfully requests issuance of a Notice of Allowance. If the undersigned attorney can assist in any matters regarding examination of this application, Examiner is encouraged to call at the number listed below.

Respectfully submitted,

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